

Inventor(s): Corner et al.  
 Appln. No.: 09  
 Series Code ↑ 843,166  
 Serial No. ↑

Group Art Unit 1764  
 Examiner: Ellen M. McAvoy  
 Atty. Dkt. P 0280189  
 M# Client Ref

Filed: April 27, 2001  
 Hon. Commissioner of Patents  
 Washington, D.C. 20231

Appln. Title: Lubricant Compositions



RECEIVED

OCT 15 2002

Sir:

**REPLY/AMENDMENT/LETTER**

Date: October 9, 2002

TC 1700

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

**FEE REQUIREMENTS FOR CLAIMS AS AMENDED**

1. Small Entity claim

- A. ☒ NOT made  
 B. ☐ Withdrawn  
 C. ☐ made herewith  
 D. ☐ made previously
- For B & C  
 See **Required  
 Separate Paper**  
 (Pat-256)

Claims remaining after amendment	Highest number previously paid for	Present Extra	Large/Small Entity	Additional Fee	Fee Code Lg/Sm
2. Total Effective Claims	9	**minus 20	0	x \$18/\$9 = + \$0	103/203
3. Independent Claims	2	***minus 3	0	x \$84/\$42 = + \$0	102/202
4. If amendment enters proper multiple dependent claim(s) into this application for first time (leave blank if this is a reissue application) .....				+ \$280/\$140 = + \$0	104/204
5. Original due Date: August 9, 2002		<input type="checkbox"/> NONE			
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached		(1 mo) \$110/\$55 = (2 mos) \$400/\$200 = (3 mos) \$920/\$460 = (4 mos) \$1,440/\$720 = (5 mos) \$1,960/\$980 =	+ \$400		115/215 116/216 117/217 118/218 128/228
7. Enter any previous extension fee paid since above original due date and subtract			- \$0		
8. Extension Fee			+ \$400		
9. If Terminal Disclaimer attached, add Rule 20(d) official fee .....			+ \$110/\$55		+ \$0 148/248
10. If IDS attached requires Official Fee under Rule 97 (c), .....			+ \$180		+ \$0 126
or if Rule 97(d) Request .....			+ \$180		+ \$0 126
11. After-Final Request Fee per rules 129(a) and 17(r) .....			+ \$740/370		+ \$0 146/246
12. No. of additional inventions for examination per Rule 129(b) .....			x \$740/370 ea		+ \$0 149/249
13. Request for Continued Examination (RCE) .....			+ \$740/370		+ \$0 1179/1279
14. Petition fee for .....			+ \$0		
15. TOTAL FEE =				\$400	
16. *If the entry in this space is less than entry in next space, the "Present Extra" result is "0".					
17. **If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.					
18. ***If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.					
				PLEASE CHARGE DEPOSIT ACCOUNT	

10/10/2002 TBESHAH1 00000054 033975 09843166

CHARGE Deposit Account No. 03-3975

Our Order No. 090128 0280189

01 FC:116 400.00 CH

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately.

Pillsbury Winthrop LLP  
 Intellectual Property Group

By Atty: Richard A. Steinberg

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NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF

Corner et al.

Application Serial No. 09/843,166

Filed: April 27, 2001

Title: *LUBRICANT COMPOSITIONS*

Confirmation No. 8587

Group Art Unit: 1764

Examiner: Ellen M. McAvoy

A12  
10/16/02  
R4

October 9, 2002

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TC 1700

RESPONSE TO FINAL REJECTION

Hon. Commissioner of Patents  
Washington, D.C. 20231  
(Box AF)

Sir:

In response to the Office Action dated May 9, 2002, please enter the following remarks in the above-identified application.

REMARKS

With removal of the final rejection, reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Claims 1-3, 5-8 and 10-11 stand rejected under 35 USC §103(a) as being unpatentable over McGraw (US 4,851,144) and Ward (US RE 33,658), considered separately, or in combination with Smalheer et al. These rejections are respectively traversed for the following reasons.

In order to establish a *prima facie* case of obviousness, the Examiner must demonstrate: 1) a suggestion to combine or modify the cited references to obtain the claimed invention; 2) a reasonable expectation of a successful combination of the references; and 3) that the cited art teaches all claim limitations of the pending application. See: MPEP §2143. The Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because there has been no showing of a suggestion to modify the cited references to obtain the claimed invention.